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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:	Russell A. Wilson	§	Art Unit:	2174
		§		
Serial No.:	09/641,431	§	Examiner:	Le V. Nguyen
		§		
Filed:	August 18, 2000	§	Atty. Docket:	ITL.0434US (P9442)
		§		
For:	Communicating Objects	§	Assignee:	Intel Corporation
	Between Users or Applications	§		
		§		
Customer No.	21906	§	Confirmation No.	6667

Mail Stop **Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION PURSUANT TO 37 C.F.R. §1.181, OR  
IN THE ALTERNATIVE, 37 C.F.R. §1.182**

The examiner's refusal to enter an amendment that was submitted in response to a new ground of rejection by the Board of Patent Appeals and Interferences is believed to be in error. The amendment was a *bona fide* attempt to comply with the Board Rules; therefore, the refusal is believed to be arbitrary and/or capricious.

11/25/2005 MGBREM1 00000036 09641431

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Date of Deposit: November 21, 2005

I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Nancy Meshkoff

### ***Facts Involved***

1. In its decision on appeal, the Board of Patent Appeals and Interferences sustained the examiner's rejection of claims 1-6, 10-16, and 20-30. The Board also entered a new ground of rejection. Namely, claims 29 and 30 were rejected pursuant to 35 U.S.C. § 101. *See* Appeal No. 2004-1673.
2. In response, a Reply to the new ground of rejection was timely filed.
3. In an Advisory Action mailed on September 22, 2005, applicant was first notified that the amendment in response to the Board's new ground of rejection would not be entered.

### ***Points to be Reviewed***

1. Was the amendment submitted on May 6, 2005 appropriate?
2. If the amendment is not considered to be appropriate, should the appellant be given the opportunity to submit an appropriate amendment?

### ***Requested Action***

The decision maker is requested to enter the amendment submitted on May 6, 2005 and the examiner is requested to consider those amendments. Alternatively, if the decision maker decides that the amendment is not appropriate, the decision maker is asked to give the appellant the opportunity to submit an appropriate amendment.

### ***Legal Argument***

When the Board makes a new ground of rejection an appellant has two choices, it may reopen prosecution or it may request a rehearing. 37 C.F.R. §41.50(b)(1). In the present case, the appellant chose to reopen prosecution by submitting an appropriate amendment. The examiner's determination that the amendment is not appropriate is in error; the amendment is appropriate and should be entered for consideration.

In the Board's decision on appeal, it rejected claims 29 and 30 on new grounds. The new ground of rejection was based on the claims being directed toward nonstatutory subject matter. Appeal No. 2004-1673, page 9. Namely, the Board said the interface did

not constitute a physical interface such as a display screen. *Id.* In response thereto, claim 29 was amended to include structural limitations.

The amendment to claim 29 is believed to be appropriate because it exceeds the threshold for what is considered to be appropriate. For example, an amendment is appropriate if one or more of the claims rejected are amended. MPEP §1214.01(I) (8<sup>th</sup> ed., 3<sup>rd</sup> revision 2005). As claim 29 was a claim rejected, and it was amended in response to the rejection, the amendment submitted on May 6, 2005 is appropriate. Moreover, the subject matter of amended claim 29 pertains to the Board's § 101 rejection; structural limitations have been added. Thus, for this additional reason the amendment is appropriate.

The appellant's amendment is not inappropriate just because it is not as broad as the examiner would like. In other words, the claims are allegedly not appropriate because they include additional limitations. *See* Advisory action, September 22, 2005. However, there is nothing in Board Rule 50(b)(1) that expressly prohibits "additional limitations." 37 C.F.R. § 41.50(b)(1). All that the Board Rule requires is for the amendment to be "appropriate." *Id.* As discussed above, the amendment is believed to be appropriate.

Amendments that are made to overcome a new ground of rejection by the Board may also include subject matter that touches on an affirmed ground of rejection. For example, in the MPEP it is acknowledged that an affirmed ground of rejection may be incidentally overcome when an amendment is made in view of the new ground of rejection. *See* MPEP §1214.01 (II). Therefore, subject matter added to overcome the Board's new rejection may also overcome a rejection that the Board has affirmed. If subject matter added by amendment were required to pertain to only the new ground of rejection without touching the merits of an affirmed rejection, the situation described in the MPEP would not arise. While the MPEP does inform that the basis of the affirmed rejection is not open to further prosecution, it is respectfully submitted that as long as the amendment is appropriate, *e.g.*, that it amends a claim rejected in a manner that addresses the Board's new ground of rejection, the amendment is appropriate. In the amendment at issue, claim 29 was amended to address the Board's § 101 rejection; therefore, the

amendment is appropriate. An incidental effect on another affirmed rejection is clearly permissible.

Moreover, the additional limitations that the examiner considers “beyond the scope” narrow claim 29 and lend cohesiveness to the claim. For example, claim 29 was amended to add a communications interface in association with a window and a controller. The controller is to persistently display the communications interface in association with the window and to enable an object to be transferred to different destinations by dragging-and-dropping the object to different locations within the communications interface. If claim 29 were to be amended to include structure without interrelating the structure to other claim elements, it would be in bad form. That is, for example, just claiming a controller does not show how the controller cooperates with other elements of the claim. Thus, the controller as claimed shows how the controller relates to a user interface (*see, e.g.,* claim 29), and how dragging-and-dropping relates to a plurality of icons representing a plurality of potential recipients (*see, e.g.,* claim 30). Therefore, for this additional reason the additional limitations are not believed to make the amendment not appropriate.

The addition of new claims in the amendment is also appropriate. For example, new claims may clearly be added when prosecution is reopened in view the Board’s new ground of rejection. MPEP § 1214(I). However, adding new claims “without *either amending the rejected claims* or substituting new claims for the rejected claims” does constitute an inappropriate amendment. *Id.* (emphasis added). In the amendment submitted on May 6, 2005, a rejected claim was amended; therefore, the mere addition of new claims was appropriate.

Even if the amendment is determined to be not appropriate, the application should not be held abandoned. Namely, at the time the amendment was made, the Board Rules were new and appellant made a *bone fide* attempt to timely comply (*e.g.,* well before the end of the two month reply period) with new Board Rule 50(b)(1). The examiner recognizes this much in the advisory action. But, the examiner’s refusal to enter the amendment (in the advisory action) came too late—over four months from the day the request to reopen prosecution was received in the USPTO. For example, extensions of time under § 1.136(a) are not applicable to time periods set forth in Board Rule 50, and the

time to request an extension of time under 1.136(b) had expired. Therefore, the appellant could not reply to the new ground of rejection after receiving the advisory action, in which case the application might be held abandoned. If the application is considered abandoned, abandonment could have been avoided had the examiner issued the advisory action before the two month period was over or if the examiner had taken another course of action. Thus, in fairness, the appellant should be given a chance to remedy the situation; the amendment filed by the appellant was one that at least tried to carry into effect a recommendation made by the Board. *See, e.g.*, MPEP § 1214.07. Indeed, the amendment incorporated structural limitations to overcome the Board's §101 rejection. Thus, the examiner's issuance of an advisory action without providing an opportunity to remedy the situation is believed to be arbitrary and/or capricious, which is against USPTO policy. *Id.* Therefore, the appellant should, if needed, be given the opportunity to comply with the new Board Rules.

Furthermore, there does not appear to be a remedy under the new Board Rules for an amendment that is a *bone fide* attempt to reopen prosecution pursuant to Board Rule 50(b)(1). For example, if an appellant takes *no action* then the examiner should proceed according to MPEP § 1214.06 (I)-(III) as appropriate, which may, in some instances, lead to abandonment. MPEP§ 1214.06(IV). Alternatively, if an appellant does take an action, such as reopening prosecution, and an application does not become allowed (or abandoned) when the prosecution of the claims rejected under Board Rule 50(b) is terminated, the file is returned to the Board so that the Board can make the original affirmance final. *Id.* Thereafter, the appellant may request a rehearing on the affirmance or seek court review. *Id.* Because the appellant in this case took an action by filing an amendment, prosecution should have been reopened. Therefore, if the amendment is not appropriate and the appellant is not given an opportunity to revise, the file should be returned to the Board so that the original affirmance may be made final.

### *Fee*

A petition brought pursuant to Rule 181 does not have a fee expressly provided for in Rule 1.17.

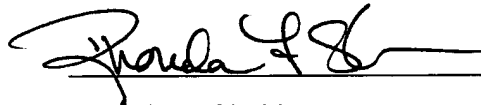
The fee associated with a petition pursuant to Rule 182 has a fee of \$400.00. A check in the amount of \$400.00 is enclosed herewith. The Commissioner is authorized to charge any fee and/or credit any overpayment to Deposit Account No. 20-1504 (ITL.0434US).

***Statement that Petition is Timely Filed***

The complained-about action took place on September 22, 2005; thus, this matter has been addressed within two months of that date.

Respectfully submitted,

Date: November 21, 2005

A handwritten signature in black ink, appearing to read "Rhonda L. Sheldon", is written over a horizontal line.

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